



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

(M)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/340,391 06/28/99 BESSETTE S 45112-023

HM22/1002

WILLEM F GADIANO ESQ
MCDERMOTT WILL & EMERY
600 13TH STREET N W
WASHINGTON DC 20005

EXAMINER

LEVY, N

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

10/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/340391

Applicant(s)

Bessette et al

Examiner

ABR Leroy

Group Art Unit

16/6

6

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/12/00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1616

Receipt is acknowledged of Declaration, CFR and IDS of 8/9/00, 10/29/99 and 5/12/00 respectively. Examiner can not understand German, Belgium; please supply translation

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what constitutes "acceptable" - carriers should be identified in the claim.

"Derivative" is indefinite (CO₂ is a derivative). "Inhibitor" is indefinite and Ambiguous; the enzyme inhibitors should also be identified in the claim. Phase I, II are indefinite, ambiguous and should be identified in the claim. It is unclear how one is to differentiate between Mono cyclic/carbocyclic- are siloxanes contemplated? Abbreviation need to be spelled out at first appearance in a claim (MGK).

Parentheses are not normally allowed in claims: what is C16 (pure)? Metabolites of transandhole are ambiguous and should be identified.

Art Unit: 1616

“Hyneryests” should be identified in the claims, as they are not generally recognized as applicant uses them. Examiner is not familiar with PD 98059, please advise.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are beyond the scope of the specification: one of ordinary skill in the art would not know which pests, how much of each active synergist and inhibitor, and which active, synergist, inhibitor should be used in order to effect control, and to provide compositions for control.

One would not know which drugs are Phase I or phase II studies.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-9, 11-14 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by

Bessette et al 6004569.

Art Unit: 1616

Carbon dioxide is an enzyme inhibitor, it is used with the instant actives and acceptable carriers (col. 14). Also shown are the instant piperonylbutoxide type synergists (col. 7).

Claims 1-4, 6-10, 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Casida-73, pyrethrin, oil and synergist are insecticidal (p.88-89). The instant flavones are also shown (p. 30-31), as are terpenols and sesquiterpenes.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casida in view of Besette et al.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize natural active compositions to use one of Casida modified with Besette to provide acceptable application. Besette teaches one having ordinary skill in the art would be motivated to perform this modification order to kill insects, not Mammals.

It has not clearly been established by an objective showing of some additional unusual and/or unexpected result that the concentration or administration of the particular active, carrier or adjuvant, chosen for the purpose for which it known or provides any greater level of prior art expectation as claimed. Further, no criticality, or objective showing of nonobvious or unexpected results is seen by the applicant to distinguish over the prior art.

Art Unit: 1616

Thus the artisan would find it obvious to prepare particular ingredient combinations, concentration and ratios of ingredients, depending upon the target species, desired number of applications, length of time for desired protection case of handling, safety to non-target species, degradation, and the use of ingredients for the functionality for which they are known to be used is not a basis for patentability. The compounds are all old, art recognized as are the recognized effects, applied by well known art recognized methods to achieve control over pests of as is well known in the art.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of active, as of claims 5 and 11.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-17 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1616

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of synergist: THFA, Forskolin, Lauandustina, PD 980509, or pyrethrin compounds.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-17 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1616

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The methods are nominal claims; if expanded, a restriction between them and composition will be made.

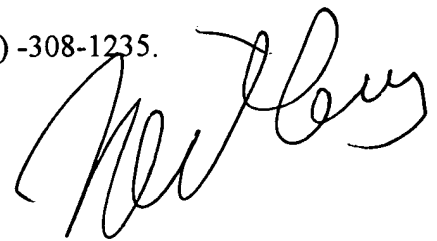
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy, whose telephone number is (703) -308-2412. The examiner can normally be reached on Tuesday through Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) -308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) -305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Levy/LR

September 18, 2000



NEIL S. LEVY
PRIMARY EXAMINER